



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,141	12/12/2000	James J. Fitzgibbon	70333	5535

22242 7590 03/21/2006

FITCH EVEN TABIN AND FLANNERY  
120 SOUTH LA SALLE STREET  
SUITE 1600  
CHICAGO, IL 60603-3406

EXAMINER

ZIMMERMAN, BRIAN A

ART UNIT PAPER NUMBER

2612

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/735,141

Applicant(s)

FITZGIBBON ET AL.

Examiner

Brian A. Zimmerman

Art Unit

2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

**EXAMINER'S RESPONSE****Status of Application**

In response to the applicant's amendment received on 1/20/06. The examiner has considered the new presentation of claims and applicant arguments in view of the disclosure and the present state of the prior art. And it is the examiner's position that claims 1-13 are unpatentable for the reasons set forth in this office action:

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1,2,5,7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu (6041410) and Flick (6140939).

Hsu teaches a garage door operating system that includes a fingerprint-communicating unit 14 which includes a fingerprint sensor 16, see figures 2 and 3. The communication unit also includes a transmitter 22 that sends a signal to the barrier operator where it is received and authenticated to open the garage door. Hsu does not expressly show the fingerprint comparison occurring at the operator, however in an analogous art, Flock teaches that either having the authentication comparison occur at the communicating unit or at the barrier operator are both equivalent methods with various pros and cons associated with each. See figures 5 and 6. Hsu does teach that communication from the key to

Art Unit: 2635

the lock should be encoded or encrypted to prevent cloning by interception. See col. 4 lines 52+. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have the fingerprint authorization occur at the barrier operator as suggested by Flock since it would reduce the processing power necessary in the fingerprint communication unit.

2. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu and Flick as applied to claims 1 and 2 above, and further in view of Nicholls.

Hsu-Flick does not teach the use of electroluminescent fingerprint sensors. Nicholls teaches of an electroluminescent fingerprint sensor such as TactileSense<sup>™</sup> by Who?Vison<sup>™</sup> as an improvement over other common fingerprint sensors. It would have been obvious to one skilled in the art at the time of invention to substitute Hsu's optical fingerprint sensor for Nicholls electroluminescent fingerprint sensor since Nicholls discloses an advantage of electroluminescent fingerprint sensors over existing fingerprint sensors, such as the immunity to the 'dry finger problem' that existed in fingerprint sensing technologies at the time of invention (Nicholls, pp 5). Who?Vison<sup>™</sup> also suggests the integration of such sensors into physical access control devices ("[xlvision.com/spinoffs](http://xlvision.com/spinoffs)").

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu and Flick as applied to claim 1 above, and further in view of Toyoda.

Art Unit: 2635

Hsu-Flick does not teach the use of Charged Coupled Devices (CCDs). Toyoda et al. teaches the use of CCDs to sense fingerprints in the production of identity authentication devices (Fig. 1). It would have been obvious to one skilled in the art at the time of invention to substitute Hsu's optical fingerprint sensor for Toyoda et al's identity authentication device using a CCD since Toyoda et al suggest that his device be used to manage entrance and exit of individuals in restricted areas (Col 1, lines 38-40) and the use of Toyoda et al's identification device using CCD would provide an improved individual identification apparatus with a high recognition ability (Col 2, lines 38-42).

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu and Flick as applied to claim 1 above, and further in view of Fitzgibbon (5751224).

Hsu-Flick does not expressly show the transmitter comprising a wall controller. In an analogous art, Fitzgibbon '224 shows the use of transmitter 34 that is a wall controller. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have mounted the Hsu-Flick transmitter on the wall of the garage since such would eliminate the need for the user to physically carry around the transmitter.

5. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu and Flick as applied to claim 1 above, and further in view of Waraksa (5412379).

Art Unit: 2635

In an analogous art, Waraksa teaches a rolling code used to mix up the id or unlocking code of the portable device to prevent cloning and unauthorized access. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have mixed a rolling code with the Hsu-Flick transmission since this would aid in preventing unauthorized access.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claim 6 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 5751224 in view of Hsu and Flick.

The combination of Hsu, Flick and the '224 patent are discussed above, and the discussion above is hereby incorporated.

***Response to Arguments***

Applicant's arguments with respect to claims 12 and 13 have been considered but are moot in view of the new ground(s) of rejection.

The applicant argues that the references do not include a controller for encoding a signal representing a fingerprint being transmitted. The combination of Hsu and Flick as discussed previously shows the transmission of a signal representing a fingerprint being transmitted. The examiner now points to a section of Hsu (col. 4 lines 52+) that teaches it would be advantageous to encode or encrypt signals transmitted to the lock, therefore, the combination of Hsu and Flick teach encoding the signal to the lock and that the signal to the lock representing a fingerprint.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

Art Unit: 2635

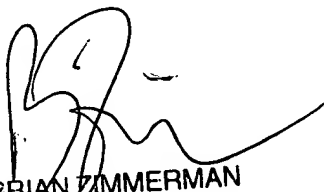
calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian A. Zimmerman whose telephone number is 571-272-3059. The examiner can normally be reached on 7 am to 4 pm E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Horabik can be reached on 571-272-3068. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BAZ



BRIAN ZIMMERMAN  
PRIMARY EXAMINER